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EXAMINER	
KESSLER, CHRISTOPHER S	

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In re application of :
MIKHAUL KEJZELMAN et al. :
Serial No. 10/689,656 :
Filed: October 22, 2003 :
For: METHOD OF PREPARING IRON-BASED COMPONENTS :
DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 16, 2008.

On January 24, 2009, a final office action was mailed to applicants rejecting all claims. A reply to the office action was filed by Applicant on June 23, 2008. In the reply, Applicant made no amendments to the claims (although a claim set was filed) and also submitted a Declaration under 37 CFR 1.132 purporting to show unexpected results. On July 16, 2008, the finality of the previous rejection was withdrawn and a new final office action was mailed.

On August 5, 2008 the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the July 16, 2008 office action.

Applicants position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that nowhere does this section of the MPEP contain any statement that would permit the Examiner to make final an Office action containing a new ground of rejection where (1) Applicant did not amend the claims at all, and (2) Applicant did not cite the information forming the basis of the new ground of rejection in an IDS filed under 37 C.F.R. § 1.97(c). This is true irrespective of whether finality of a previous Office action was withdrawn.

Petitioner further argues that in the present application, the Office action of July 16, 2008 acknowledges that no amendment was made to the claims in the response filed on June 23, 2008.

A review of the record of IDS's filed by Applicants in this application makes clear that neither Ozaki et al. nor Ferguson et al. were cited by Applicants in an IDS filed under 37 C.F.R. § 1.97(c). Accordingly, the requirements of MPEP § 706.07(a) for making final the July 16, 2008 Office action have not been met. Petitioner submits that, as a result, such finality is improper and should be withdrawn.

A review of the record shows that in the final rejection of January 24, 2009, claims 20-30, 34-40, 48 and 49 were rejected under 35 USC 103(a) as being unpatentable over Ozaki in view of Rutz. Additionally, claims 20-25, 30, 34-40, 48 and 49 were rejected under 35 USC 103(a) as being unpatentable over Rutz in view of Kondo.

In the most recent final rejection of July 16, 2008, claims 20-25, 30, 34-40, 48 and 49 were rejected under 35 USC 103(a) as being unpatentable over Rutz in view of Kondo. In addition, a new rejection of claims 20-30, 34-38, 40, 48 and 49 under 35 USC 103(a) as being unpatentable over Ozaki alone was made. Finally, claim 39 was newly rejected under 35 USC 103(a) as being unpatentable over Ozaki in view of "Powder Shaping and Consolidation Technologies," ASM Handbook, vol. 7, 1998, pp. 313-320 (hereinafter "Ferguson").

The new grounds of rejection of claims 20-30, 34-38, 40, 48 and 49 over Ozaki alone was improper. The new grounds of rejection of claim 39 over Ozaki in view of Ferguson likewise improper. As such, the finality of the office action was premature and the petition for withdrawal of finality is **GRANTED.**



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